

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) CM06328J
I hereby certify that this correspondence is being electronically transmitted on the date listed below [(37 CFR 1.8(a))]. on: <u>July 22, 2008</u> Signature <u>/Barbara R. Doutre/</u> <u>Barbara R. Doutre</u> Typed or printed name	Application Number 10/660,213 First Named Inventor Darren T. Sapashe et al Art Unit 2615	Filed September 11, 2003 Examiner FAULK, Devona E.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheets(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; margin-top: 10px;"> <div style="width: 45%;"> <input type="checkbox"/> applicant inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registraton number <u>39,505</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: _____ </div> <div style="width: 45%; text-align: right;"> <u>/Barbara R. Doutre/</u> Signature <u>Barbara R. Doutre</u> Typed or printed name <u>(954) 723-6449</u> Telephone number <u>July 22, 2008</u> Date </div> </div> <p style="margin-top: 20px;">NOTE: Signatures of all the inventors or assignees or record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, se below*</p>		
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.		

(SB/33 (07-05))

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	Darren T. Sapashe, et al	Art Unit:	2615
Application No.:	10/660,213	Examiner:	FAULK, Devona E.
Filed:	September 11, 2003	Confirmation No.	6551
Title:	METHOD AND APPARATUS FOR MAINTAINING AUDIO LEVEL PREFERENCES IN A COMMUNICATION DEVICE		

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the Final Office Action mailed April 23, 2008 and Advisory Action mailed July 14, 2008, concerning the above-identified application in furtherance of the Notice of Appeal filed on July 22, 2008. Claims 1, 2, 3 and 5 remain pending in the application, a copy of which can be found in Applicant's response of May 8, 2008.

REMARKS

Claims 1-3 and 5 were objected to because claim 1-3 and 5 recite "...monitoring only background noise levels..." or monitoring subsequent background audio level alone."

The Final Action (page 2, item 4) refers to Applicant's specification page 4, lines 12-19 as not being supportive of this language and the Advisory Action page 2 refers to page 2, lines 18-21 as not being supportive. Referring to page 2, lines 18-21, the specification recites: "[I]n accordance with the present invention, an intelligent automatic volume control technique takes a

measurement of the environment (background noise) at the time a user manually selects the volume.” The specification defines the environment as background noise and as such the audio environment defined on page 4, lines 12-19 only refers to background noise. Additionally, FIG. 2 clearly shows only BACKGROUND NOISE ENVIRONMENT being sampled by microphone (214). Also, in the flowchart of FIG. 1 all of the steps deal with background levels alone. Thus, Applicant maintains that the specification sufficiently supports the use of the word “alone” and “only” within the claims. Applicant respectfully requests the objection be withdrawn.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

Again, claims 1-3 and 5 were objected to for the steps of “monitoring only background noise levels” and “... monitoring subsequent background audio level alone.” As argued above, Applicant respectfully maintains that the specification sufficiently supports the use of the terms “only” and “alone” via FIG. 2 microphone (214) measuring BACKGROUND NOISE ENVIRONMENT; FIG. 1 and at least page 2, lines 18-21. Applicant requests that the objection to the specification now be withdrawn.

Claims 1-3 and 5 were rejected under 35USC112, first paragraph due to the recitation of the words “only” and “alone” referring to page 4, lines 12-19.

Applicant respectfully traverses. As argued above, Applicant asserts that the audio environment being sampled has sufficiently been described as being Background Noise only via at least page 2, lines 18-21, FIG. 2 microphone (214) measuring BACKGROUND NOISE; and FIG. 1. Accordingly the rejection under 35 USC 112, first paragraph should be withdrawn.

Claims 1-3 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helms (US Patent 5,666,426) in view of Cooper (US Patent 5,790,671).

Neither reference taken individually or in combination teaches that which is claimed by Applicant's invention. Both Helms and Cooper consider BOTH the desired signal and noise and do not consider background noise alone as claimed by Applicant's independent claims.

The Helms reference teaches measuring an amplified output signal (the desired signal) and the background signal simultaneously. The Helms reference requires measuring both the desired (amplified output) signal and the background signal. As seen in FIG. 1, steps 32, 34 and col. 4, lines 1-7, as well as the independent claims, the Helms reference samples not only the background noise but also the amplified output signal simultaneously. This is done out of necessity, since the signal that Helms is controlling is constantly playing out, such as from a car radio.

The Helms technique is not optimal, particularly in the case of two-way radios (claims 1 and 5), as the Helms technique can not sense background noise alone. All of Applicant's claims (1, 2, 3 and 5) are directed to measuring the background levels only – there is no recitation or requirement of measuring the desired/amplified output signal. The Helms reference is not applicable to the two-way environment, specifically called out in claims 1 and 5. The very nature of a two-way radio is that the speaker is turned OFF when the microphone is active. Hence, when the microphone samples the background audio levels in Applicant's invention, audio from the speaker is not picked up. Applicant samples only the background noise - and not what is coming out of the speaker.

On page 4 of the Final Action, The Examiner concedes that Helms fails to disclose switchably engaging a microphone, but interprets this as “selectively engaging a microphone”

referring to col. 4, lines 21-32 of Cooper. The Advisory Action, page 2 third paragraph states that this passage teaches an *implied switching or selectively engaging a microphone*. Applicant has reviewed this passage of Cooper in its entirety and asserts that there is no teaching either direct or implied of switchably engaging a microphone or selectively engaging a microphone. The portion of the passage dealing with a microprocessor “skipping ahead” in one condition or “fetching” in another condition does not equate to switchably engaging a microphone or selectively engaging a microphone. The portion of the passage that checks the ambient noise level (which as discussed includes BOTH the desired and noise) is based on the volume setting or direct sampling using the microphone audio input 22 and thus does not teach or suggest switching or selectively engaging the microphone. The portion of the passage dealing with the microprocessor “accessing an audio parameter table” based on the “volume setting” or “sample ambient noise” does not in any way imply switching or selectively engaging a microphone.

Again, as stated above, the “ambient noise” of Cooper includes BOTH the background noise and the speaker output signals. In col. 1, lines 15-20 Cooper states: “increasing the volume adds to the pre-existing high ambient noise level, which could result in other noise sources increasing their volume, thereby further aggravating the problem.” Thus, Cooper’s own volume (speaker) adds to the pre-existing high ambient noise. Accordingly, Cooper teaches away from switchable or selectable since Cooper considers volume level as a component of the sampled ambient. Much like Helms, Cooper is using BOTH the desired and the noise signal in determining ambient level while Applicant’s have a switchable microphone and only measure background noise.

Therefore, the combination of Helms and Cooper do not teach or suggest the claim limitation of “monitoring subsequent background audio level alone by switchably engaging a

microphone of the two-way radio' as claimed in claim 1; or "monitoring only subsequent background audio levels by switching in a microphone when a change in manual volume control setting occurs" as claimed in claim 2; or "a microphone switchably coupled to the controller for monitoring only background noise levels in response to changes in the manual volume control" as required claim 3; or "a microphone coupled to the controller via a switch, the microphone sampling subsequent background audio levels alone in response to a subsequent change to the manual volume control being sensed by the intelligent automatic volume control and the intelligent AVC engaging the switch" as recited in claim 5.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1- 3 and 5 under 35 U.S.C 103(a). Applicant requests that claims 1- 3 and 5 now be passed to allowance.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Such action is earnestly solicited by the Applicant.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

July 22, 2008

Motorola, Inc.
Customer Number 24273

By: /Barbara R. Doutre/
Barbara R. Doutre
Attorney of Record
Reg. No.: 39,505
Tel: 954-723-6449
Fax: 847-576-3750
E-Mail: docketing.schaumburg@motorola.com